

PATENT**Application # 09/642,980****Attorney Docket # 1999-0587 (1014-091)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claim 68 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 42 and 45-68 are now pending in this application. Each of claims 42, 45, and 68 are in independent form.

The Obviousness Rejections

Each of claims 42 and 45-68 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Bennefeld (U.S. Patent No. 6,519,249), Andersson (U.S. Patent No. 6,693,894), Galasso (U.S. Patent No. 6,374,302), Wiryaman (U.S. Patent No. 6,157,401), Lu (U.S. Patent No. 6,100,918), Jain ("Mobile Internet Access & QOS Gurantees Using Mobile IP and RSVP with Location Registers"), Tiedemann (U.S. Patent No. 5,862,471), and/or Chau (U.S. Patent No. 5,764,750). These rejections are respectfully traversed.

PATENT**Application # 09/642,980****Attorney Docket # 1999-0587 (1014-091)****A. Galasso was a Commonly Owned Reference**

The present application and U.S. Patent No. 6,374,302 (Galasso) were, at the time the invention of the present application was made, owned by or subject to an obligation to assign to AT&T Corp. Accordingly, Galasso does not qualify as a reference under 35 U.S.C. 103 (c), and the withdrawal of the assertion of Galasso as a reference is respectfully requested.

B. *Prima Facie* Criteria

Without Galasso, none of the remaining applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

C. Missing Claim Limitations

Each of independent claims 42, 45, and 68 recites, *inter alia*, a "non-gatekeeper database". The applied portions of the available relied upon references do not expressly or inherently teach or suggest a "non-gatekeeper database".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully

PATENT**Application # 09/642,980****Attorney Docket # 1999-0587 (1014-091)**

traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. See *In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:

"none of the reference of record, alone or in combination, teach or suggest the combination of limitations found in the independent claims. Namely, claims 42 and 45-68 are allowable because none of the references of record, alone or in combination, teach or suggest a 'non-gatekeeper database'".

JAN 31 2006

PATENT

Application # 09/642,980

Attorney Docket # 1999-0587 (1014-091)

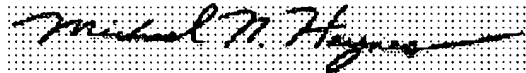
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 31 January 2006

Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850